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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,638	09/11/2000	John K. Schneider	13325.0032	4826

7590

01/25/2005

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EXAMINER

DANG, DUY M

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/658,638

Applicant(s)

SCHNEIDER ET AL.

Examiner

Duy M Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's amendment filed 9/1/04 has been entered and made of record.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomko (US Patent No. 5,790,668) in view of Fishbine et al. (US Patent No. 5,467,403).

Regarding claim 1, Tomko teaches a fingerprint identification system (see Title, Abstract, and figure 1) comprising:

a fingerprint scanner (see "biometric input devices" shown at 20, 120, and 220 of figure 1 and further detailed in figures 2-3 and mentioned in col. 3 lines 39-51. These mentioned biometric input device function as the so called "a fingerprint scanner"); and

at least one docking station (see the "docking stations" shown at 28 and 30 in figure 1 and mentioned in col. 3, lines 11-13).

While Tomko teaches a fingerprint scanner, Tomko does not explicitly teach whether or not his/her fingerprint scanner is a portable fingerprint scanner.

However, Fishbine teaches a fingerprint identification system (see Title, Abstract, and figure 1) comprising a portable fingerprint scanner (see "a portable image collection unit" shown at 10 in figures 1 and 5 and mentioned in col. 3 lines 18-23 comprising a fingerprint scanner 12 according to col. 3 lines 27-29 qualifies as the so called "a portable fingerprint scanner") connected to base unit via RF link (see col. 4 lines 30-37 and col. 3 lines 35-50: note that RF link

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interconnection refers to the physical separation between the fingerprint scanner 10 and base unit 8 when fingerprint scanner 10 is obtaining fingerprint images. It is also noted that base unit 8 in Fishbine also functions as the so called “docking station”), and a storage included in the portable fingerprint scanner for storing fingerprint images captured (see recording media included in scanning camera 18 as mentioned in col. 5 lines 57-58 and figure 1, and the “terminal 28 memory” for storing fingerprint image from scanning camera 18 according to col. 5 line 63 to col. 6 line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a portable fingerprint scanner as taught by Fishbine in combination with Tomko as suggested by Fishbine in col. 2 lines 2-17. In addition, by incorporating such portable fingerprint scanner would greatly enhance: (1)light weight, (2)cost saving because it could be shared with other user in the same operation environment, and (3) heat reduction thereby improving reliability.

Regarding claim 2, Tomko further teaches a computer used for processing fingerprint images downloaded from fingerprint scanner (see processor 14 of figure 1 and its corresponding text portion mentioned in col. 3 line 65 to col. 4 line 22).

Regarding claim 3, Tomko further teaches wherein diagnostic routines are provided by the computer for operation on the scanner while in the docking station (This feature is inherently included in Tomko because in order for the image captured by the scanner to be downloaded. In addition, this is how docking station functions to provide a connection between input device (120 and 220 of figure 1) and processor 14 so the processor 14 can “talk” to the biometric input devices 120 and 220 for downloading image captured by said biometric input devices).

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transferred via two-way communication shown at s i these features (see figures 1, and 4-5; and col. 3, lines 3-30. Also refer to Fishbine, 1, and 4-7; Abstract; col. 3, lines 18-50; and col. 4, line 59 to col. 5, line 14).

Regarding claim 7, While Tomko does not teach wherein the docking station is located in a law enforcement vehicle, Tomko does teach docking station is two-way communication connected to the computer (see figure 1 where processor/computer 14 connects to the docking stations 28 and 30. It is well known in the art that wireless can be used in providing two way communication as evidenced by Fishbine in col. 1 lines 14-16. Fishbine also teaches the use of such system in the law enforcement environment (see col. 1 lines 58-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the conventional teachings as taught by Fishbine in combination with Tomko in order to provide real-time biometric data verification, easy to carrying and use at the remote location such as crime site.

Regarding claim 8, both Tomko and Fishbin fail to explicitly teach wherein the scanner is provided with an external magnetic component for attachment to a vehicle during use in obtaining images. It is well known in the art (Official Notice) to use such magnetic for attachment scanner to the vehicle during use in obtaining image in order to physically secure the scanner thereby to prevent damaging to the image captured and scanner itself due to the vibration.

Regarding claim 9, Fishbine further the use of infrared data link for wireless transmission (see col. 10 line 5).

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4. Claims 4, 6, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomko (US Patent No. 5,790,668) in view of Fishbine et al. (US Patent No. 5,467,403) as applied to claims 1-3 and 7-9 above, and further in view of Delagrange et al. (US Patent No. 5,878,211).

The advanced statements in paragraph 3 with regard to the combination of Tomko and Fishbine et al. as applied to claims 1-3 and 7-9, above, are incorporated herein.

With regard to claims 10-11, Tomko does not specifically teach a supervisor docking station, Tomko does teach a plurality docking stations. It is well know in the art that the term docking station includes supervisor docking station as evidenced by Delagrange.

Delagrange teaches a security system using fingerprint scanner and a supervisor docking station (see col. 7, lines 10-22; and figure 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a supervisor docking station as taught by Delagrange in combination with Tomko because by including such station would greatly enhance the security.

With regard to claims 4 and 6, while Tomko does not explicitly teach that the docking station is provided with a voltage source for recharging the scanner battery when in the docking station, Tomko does teach a plurality of docking stations. Such features are well known and routinely used in the art as evidenced by Delagrange.

Delagrange teaches a security system using fingerprint input device and docking station (see col. 7, lines 10-22; and figure 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to include such features as taught by Delagrange in combination with Tomko because

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by including such features would greatly enhance: (1) cost reduction because the cost of recharging the battery is much lower than the cost of replacing the battery; and (2) convenient because battery can be recharged while docking; (3) broader application thereby increase market capability when it is used as barcode reader.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomko (US Patent No. 5,790,668) in view of Fishbine et al. (US Patent No. 5,467,403) as applied to claims 1-3, and 7-9 above, and further in view of Schneider et al. (US Patent No. 5,456,256).

The advanced statements in paragraph 3 with regard to Tomko and Fishbine et al. as applied to claims 1-3, above, are incorporated herein.

Tomko does not specifically teach that the scanner is an ultrasonic fingerprint scanner. However, the utilization of an ultrasonic fingerprint scanner is well known in the art as evidenced by Schneider. Schneider teaches an ultrasonic fingerprint scanner (see title and abstract. Also refer to figures 28-29).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a ultrasonic fingerprint scanner as taught by Schneider in combination with Tomko as suggested by Schneider in column 28, lines 10-17.

6. Applicant's arguments filed 9/1/04 have been fully considered but they are not persuasive.

In response to applicant's arguments (see second paragraph of page 5 to last paragraph of page 7), the examiner disagrees because the combination of Tomko and Fishbine et al. teaches the claimed features as pointed out in the claim rejection section above. For example, Tomko teaches fingerprint scanners (see "biometric input devices" shown at 20, 120, and 220 of figure 1

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and mentioned in col. 3 lines 39-51) and at least one docking station (see the “docking stations” shown at 28 and 30 in figure 1 and mentioned in col. 3, lines 11-13) are connected via two way communication (see col. 3 lines 10-16). In addition, Fishbine et al. teaches a fingerprint identification system (see Title, Abstract, and figure 1) comprising a portable fingerprint scanner (see “a portable image collection unit” shown at 10 in figures 1 and 5 and mentioned in col. 3 lines 18-23 comprising a fingerprint scanner 12 according to col. 3 lines 27-29 qualifies as the so called “a portable fingerprint scanner”) connected to base unit 8 via RF link (see col. 4 lines 30-37 and col. 3 lines 35-50: note that RF link interconnection refers to the physical separation between the fingerprint scanner 10 and base unit 8 when fingerprint scanner 10 is obtaining fingerprint images. It is also noted that base unit 8 in Fishbine also functions as the so called “docking station”), and a storage included in the portable fingerprint scanner for storing fingerprint images captured (see recording media included in scanning camera 18 as mentioned in col. 5 lines 57-58 and figure 1, and the “terminal 28 memory” for storing fingerprint image from scanning camera 18 according to col. 5 line 63 to col. 6 line 6).

In response to applicant's argument (see second paragraph of page 6) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tomko teaches fingerprint input devices (20, 120, and 220 of figure 1) connected to docking stations (28 and 30 of figure 1) via



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communication link (118 and 218 of figure 1) and Fishbine et al. teaches a portable fingerprint image collection unit 10 connected to base unit 8 via interface 9 as shown in figure 1. Fishbine et al. further teaches utilizing wireless communication between unit 10 and base unit 8 according to col. 4 lines 30-37. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a portable fingerprint scanner as taught by Fishbine in combination with Tomko as suggested by Fishbine in col. 2 lines 2-17. In addition, by incorporating such portable fingerprint scanner would greatly enhance: (1)light weight, (2)cost saving because it could be shared with other user in the same operation environment, and (3) heat reduction thereby improving reliability.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M Dang whose telephone number is 703-305-1464. The examiner can normally be reached on Monday to Friday from 5:30AM to 2:00PM..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



dmd  
1/20/05



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